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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/914,536	08/19/97	STEVENSON	STEVE-106*

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IM61/0427

EXAMINER

CAMERON, E

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 04/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/914,536

Applicant(s)
Stevenson et al

Examiner
Erma Cameron

Group Art Unit
1762



☒ Responsive to communication(s) filed on Mar 22, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 5, 7, 8, 15-17, 20, and 39-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 5, 7, 8, 15-17, 20, and 39-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Applicant's arguments filed 3/22/1999 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

1. The rejection of Claims 1-2, 5, 7-8, 15-17 and 20 are rejected under 35 U.S.C. 112, second paragraph, is withdrawn because of the amendment filed 3/22/1999.
2. Claims 1-2, 5, 7-8, 15-17, 20 and 39-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instructions in the amendment filed 3/22/1999 are not clear; which instance of liquid carrier is meant (17:28) ?

3. Claims 1-2, 5, 7, 8, 15-17, 20 and 39-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the composition as claimed in Claim 1 as originally filed, does not reasonably provide enablement for the broader composition of Claim 1 as amended 3/22/1999. The specification does not enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

4. Claims 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

“Liquid carrier in an amount to provide the decorative enhancement composition with a consistency and viscosity necessary for application by liquid means of application” and “binder in an amount to provide adhesion of the decorative enhancement composition to said polyethylene surface” and “powder in an amount sufficient to fuse into and form a permanent bond with the molded polyethylene article” are new matter, not supported by the application as originally filed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-2, 5, 7-8, 15-17, 20 and 39-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/23041.

'041 teaches a thermoplastic spray material for bonding to polyethylene (p4) where the composition comprises 5-95% polyethylene powder with particle size less than 50 microns (p18-19), organic or inorganic pigments or mixtures, organic solvents or water or mixtures (p19), and resin particles such as rosins or hydrocarbon resins (p21). After application to a surface, the composition is heated (p20).

The composition of '041 overlaps with applicant's claimed ranges.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. See *In re Malagari* 182 USPQ 549.

'041 does not teach a clear overcoat, but a color-plus-clear type of surface coating is conventional to the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a protective clear overcoat to the pigmented coating of '041, for protection.

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Applicant's only argument in the 3/22/1999 amendment is that they claim a continuation - in-part priority of 08/566906, filed 12/4/1995. However, the present application is not entitled to the filing date of 08/566906 because the present application recites the feature of a colorant and also a coating composition (20-90 percent liquid carrier, 9-50 % colorant + 50-91 % of binder and particulate thermoplastic powder) that is different from that of 08/566906. See MPEP 201.11.

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Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is (703) 308-2330.



ERMA CAMERON
PATENT EXAMINER
GROUP 1100

Erma Cameron

April 26, 1999